

Appl. No. 10/824,889
Amdt. dated October 6, 2005
Reply to Office action of Sept. 1, 2005

Amendments to the Drawings:

The attached sheets of drawings includes changes to Fig. 5 by eliminating tag marker 20 and repositioning tag marker 22 in Fig. 6 to indicated the tip of the toe nail 12, Item 72 has been changed to item 77 in Fig. 25. These sheets, which includes Figs. 5, 6 and 25 replaces the original sheets including Fig. 5, 6, and 25, previously submitted,.

Attachments: Replacement Sheets and Annotated Sheets Showing Changes

REMARKS/ARGUMENTS

In the specification, paragraphs 1 and 2 on page 8-10 have been amended to correct minor editorial problems.

Claims 1-7, 11 and 14-17 remain in this application and are currently amended .
Claims 8-10, 12, 13, 18-26 have been withdrawn.

The examiner has acknowledged that claims 1-7, 11 and 14-17 are directed to allowable subject matter. Claim 8-10, 12, 13, 18-26 have been withdrawn as the result of an earlier restriction requirement.

Claim objections

6. *Claims 1-7, 11 and 14-17 objected to because of the following informalities: the claims interchange the "polymeric sheath" as both the combination of the sheath and the second polymer layer and the polymeric sheath as a singular entity. It is suggested the Applicant use a preamble such as "An animal toe nail covering comprising. . . ." To differentiate the combination as the "toe nail covering" and the internal structure as the "polymeric sheath". Appropriate correction is required.*

Response: Claims currently amended accordingly to more clearly establish the combination claimed

7. *Claim 2 is objected to because of the following informalities: the applicant has stated the second layer of polymer has a durometer greater than that of the polymeric sheath. The term "durometer" is used in inappropriate context, as it is an instrument for measuring hardness. As such, the claim has been interpreted to mean, "the second layer of polymer has a hardness greater than that of the polymeric sheath." Appropriate correction is required.*

Response: Claim 2 is currently amended to avoid the objection. However, Examiner is misinformed with the terminology used within the art relating to the term "Duormeter". We offer Exhibit "A" as a showing of such common practice within the art.

8. *Claim 7 is objected to because of the following informalities: line 2, replace "sheaths" with - -sheath- -. Appropriate correction is required.*

Response: Claim currently amended

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9. Claims 7, 14 and 15 are objected to because of the following informalities: these claims include a limitation to "adhesive means" which are not supported by a proper antecedent basis. Replacing "means" with -element- - would obviate this objection. Appropriate correction is

Response: Claims currently amended

Claim Rejections-35 USC 112

11. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: a releasing agent. The specification states that the delamination property is a result of the releasing agent. The polymeric sheath does not comprise a delamination but provides for delamination via the releasing agent.

Response:

Examiner has ignored the exceptions to rule MPEP § 2172.01 which further states

It is not essential to a patentable combination that there be interdependency between the elements of the claimed device or that all the elements operate concurrently toward the desired result"; *Ex parte Huber*, 148 USPQ 447, 448-49 (Bd. Pat. App. 1965) (A claim does not necessarily fail to comply with 35 U.S.C. 112, second paragraph where the various elements do not function simultaneously, are not directly functionally related do not directly inter-cooperate and/or serve independent purposes..

Examiner seems to suggest that the claim must include a means for obtaining the claimed delamination (a result of separation).

The mere fact that the apparatus has such a delamination as a claimed limitation for its construction is sufficient. The rule makes no assertion that a means for obtaining the desired result be included in the claim, in fact the rule stipulates that It is not essential for a patentable combination that there be interdependency between the elements (Sheath and Coating or release agent) of the claimed device or that all the elements operate concurrently toward the desired result (delamination).

There is no requirement for an apparatus claim to provide a functional method for achieving the intended result of (purposeful delamination). A method or process

claim is usually used to define the method or process for achieving such delamination.

Further, delamination is a result of an imperfect lamination. There is no reason for the claim to stipulate why the delamination occurs. The mere fact that the delamination is being claimed gives rise to the assumption that it has a purpose. The purpose of the delamination is to provide a pocket for an adhesive therefore the result is to form a void for inserting an adhesive and not the end result of delamination. How the delamination is achieved (via a release agent) is simply a process.

Claim Rejections 35 USC 102

Examiner's rejections:

Claims 1, 2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Field, US Patent 4,908,881.

Field discloses a polymeric sheath (44) having an opening (46) and an internal and external shape generally consistent with that of an animal's toenail, the polymeric sheath comprising a second layer of polymer (48) covering at least a portion of the polymeric sheath (reference Figure 3).

Response: Rejection under 35 U.S.C. 102(b) requires that the cited reference must anticipate each and every aspect of the invention as claimed including its limitations.

The Field *finger* cot or covering does not disclose an article shape consistent with that of an animal toenail. Animal toenails are curved and pointed unlike that of a human finger which comprises a fingernail and a fingertip not a toenail. The instant claim nail cap surrounds and is fitted to only the animal's nail and not the toe. This is why its called an animal nail cap and not a toe cap.

Field does not teach or suggest the use of his decorative finger cot for use on an animal's toe nail or as a sheath for a toenail.

The size of the sheath as defined in the instant specification clearly indicates the sheath to be a very small item, often installed on the animal toenail with tweezers or forceps. The Field finger does not meet any of these conditions.

The difference between a human finger and an animal toenail covering has been well established during the prosecution of U.S. Patents 4,962,731 and 6,659,047.

The Field decorative appliqué is detachably mounted within a recessed notch according to the Field specification and not adhered as suggested by examiner. In fact there is nothing to suggest that the Field appliqué is considered to be a second layer which suggest that a first layer exist.

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The Field disclosure teaches a false finger nail applied to a finger cot. The finger cot is applied to the digit of a human finger and the false fingernail applied to the cot. As currently amended claim 1 of the instant invention refers to a coating applied to an animal toenail covering that *encompasses* at least a portion of the toenail covering. Note: the false fingernail disclosed by Field is not a coating nor does it encompass at least a portion of an animal toenail covering.

Regarding Claim 2, Field discloses the second layer of polymer is harder than that of the polymeric sheath (column 3, line 17 and column 3, lines 27-30).

Response: The simi-ridged sheath 40 as disclosed by Field is a *slightly pliable plastic* and the false fingernail insert may be formed of a ridged plastic. These statement by Field in no way suggest hardness of the material used. Flexibility or rigidity is not necessarily a product of a material's hardness but could just as easily be achieved through a structural differences in thickness. Since Fields does not mention "hardness" examiner is making an incorrect assumption.

Regarding claim 5, Field discloses that the second layer may be removable from the sheath thereby providing the sheath with the delamination between the sheath and the second layer of polymer.

Response: Examiner is incorrect in her assumption regarding the term "delamination". To have a delamination the material must first have to be laminated or bonded. Since there is no mention by Field that the false fingernail is laminated or bonded in any way and is simply mounted or attached within a recessed notch, it can not be assumed that a lamination ever existed or that a delamination has occurred. The term "delaimanation" has a different meaning than the term "detachment". In any case claim 5 as amended now refers to a partial delamination

Claims 3, 6, 7 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Field, US Patent 4,908,881.

Field discloses the invention as claimed. However, Field does not positively disclose that the second layer of polymer is a different color than the polymeric sheath. Field does disclose that the second layer may be prepared in various colors and designs for aesthetic purposes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a sheath of differing color than the second polymer layer so as to provide more contrast and thereby add to the aesthetic nature of the device.

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Response: Although Field does mention the use of colored plastic, the detachable false fingernail item 48 is not a coating encompassing the sheath as currently amended by applicant. The sheath taught by field is a human finger covering surrounding the first joint portion of a human finger including the fingernail. Whereas, applicant claims an animal toenail sheath or covering well establish within the art as being patentable distinct from human finger sheaths and false finger nails. The Field invention does not have an internal and external shape generally consistent with that of an animal toenail nor does it encompass only the nail. Therefore, there is no indication in the cited reference of Field teaches or otherwise suggest the finger sheath could be used as a covering for an animal toenail or that an animal toenail sheath could or should include a secondary coating encompassing a portion of the sheath or that the coating could or should have a harder durometer or be a different color than the sheath. There is no evidence that anyone of ordinary skill in the art of making, using selling animal toenail cap would have been able to derive any inspiration from the Field disclosure prior to the invention of the presently claimed toenail covering. Field fails to disclose, teach or suggest the claimed invention or a process for making such an invention.

Recently decided cases set forth the need for the cited reference to provide a motivating suggestion that is explicit as decided in Winner International Royalty Corp. v. Wong, No 96.2107, 48 USPQ.2d 1139 (D.C.D.C.1998) Where the court held:

".... Inventions can not be found obvious unless there was some explicit teachings or suggestion in the art to motivate one of ordinary skill to combine elements so as to create the same invention." [at 1140] [at 1144]. Case Upheld by the CAFC .

"The prior art must provide one of ordinary skill in the art the motivation to make the proposed molecular modifications needed to arrive at the claimed compound."

"Moreover the Courts have advocated that even if the prior art may be modified as suggested by the Examiner, the modification is not obvious unless the prior art suggest the desirability for the modification. See In re. Fritch, 9922 F.2d 1260, 23 USPQ.2D 1780 (Fed. Cir. 1992." where the court held

"The mere fact that prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention obvious unless desirability of such modification is suggested by prior art... [at 1780] See also Gordon, 733 F.2d at 902, 221 USPQ at 1127." [at 783]

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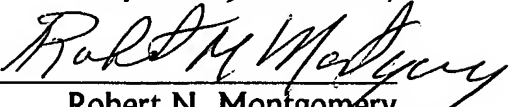
Regarding claim 6, Field discloses that the second polymer layer is mounted to the sheath. While not positively stating that an adhesive element is used, it is obvious that such an adhesive element must be present as there is no structural mechanism in which to retain the second polymer layer onto the sheath.

Response: Examiner is making an unqualified assumption regarding this claim. There are indeed a number of ways to attach a false fingernail to the notched area provided in the finger sheath, such as grooves, dimples, static cling, or vacuum adhesion to name a few. The false fingernail like insert could be simply a ridged plastic film appliqué having an emulsion that becomes molten with heat. Assumptions are endless and should be avoided.

In any case the reference must clearly teach or suggest the presence of a liquid adhesive applied between the animal toenail sheath and the coating encompassing the sheath and thus encapsulated there between as currently amended. The cited reference of Field makes no such suggestion.

In view of the examiner's earlier restriction requirement, applicant retains the right to present claims 8-10, 12, 13, 18-26 in a divisional application

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,
By 
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3-Attachments



EXHIBIT (A)



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SEARCH

Shore (Durometer) Hardness Testing of Plastics

The hardness testing of plastics is most commonly measured by the Shore (Durometer) test or Rockwell hardness test. Both methods measure the resistance of plastics toward indentation and provide an empirical hardness value that doesn't correlate well to other properties or fundamental characteristics. Shore Hardness, using either the Shore A or Shore D scale, is the preferred method for rubbers/elastomers and is also commonly used for 'softer' plastics such as polyolefins, fluoropolymers, and vinyls. The Shore A scale is used for 'softer' rubbers while the Shore D scale is used for 'harder' ones. Other Shore hardness scales, such as Shore O and Shore H hardness, are rarely encountered by most plastics engineers.

The Shore hardness is measured with an apparatus known as a Durometer and consequently ~~is also known as~~ ~~Durometer hardness~~. The hardness value is determined by the penetration of the Durometer indenter foot into the sample. Because of the resilience of rubbers and plastics, the indentation reading may change over time - so the indentation time is sometimes reported along with the hardness number. The ASTM test method designation is ASTM D2240 00 and is generally used in North America. Related methods include ISO 7619 and ISO 868; DIN 53505; and JIS K 6301, which was discontinued and superseded by JIS K 6253.

The results obtained from this test are a useful measure of relative resistance to indentation of various grades of polymers. However, the Shore Durometer hardness test does not serve well as a predictor of other properties such as strength or resistance to scratches, abrasion, or wear, and should not be used alone for product design specifications.

As seen in the charts below, the correlation between the two Shore Durometer hardness scales is weak; attempts at conversion between the scales are therefore discouraged. The correlation is higher for materials with similar resiliency properties, but is still too low for reliable conversions. Likewise, conversion between Shore Hardness and Rockwell hardness is discouraged.

The charts below are taken from data in MatWeb's database provided by polymer manufacturers for specific product grades.

Comparison of Shore Hardness Scales

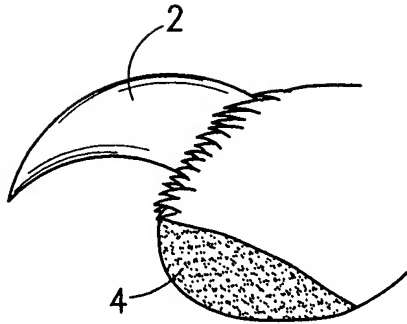


Fig. 1

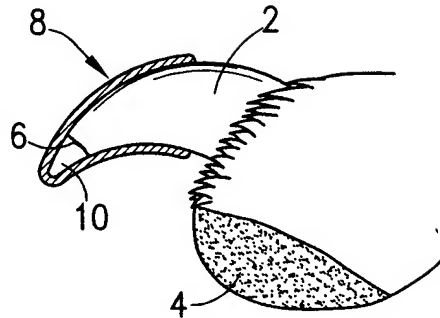


Fig. 2
PRIOR ART

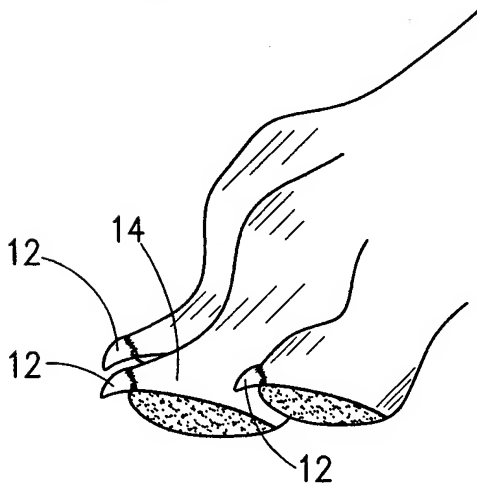


Fig. 3
PRIOR ART

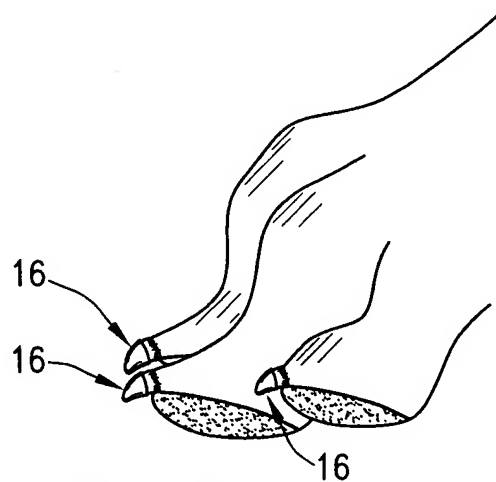


Fig. 4
PRIOR ART

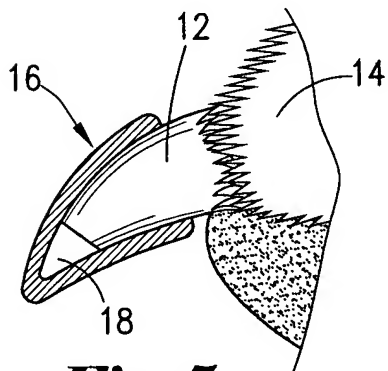


Fig. 5
PRIOR ART

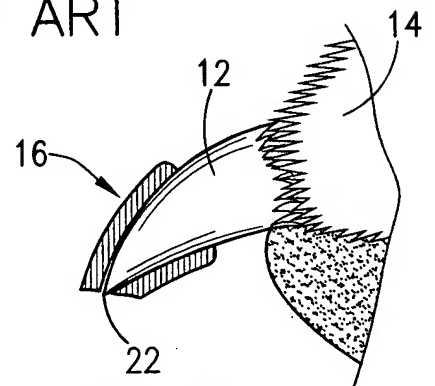
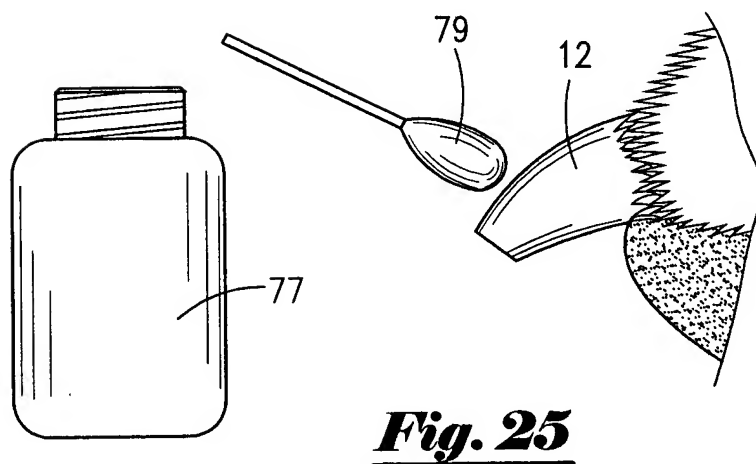
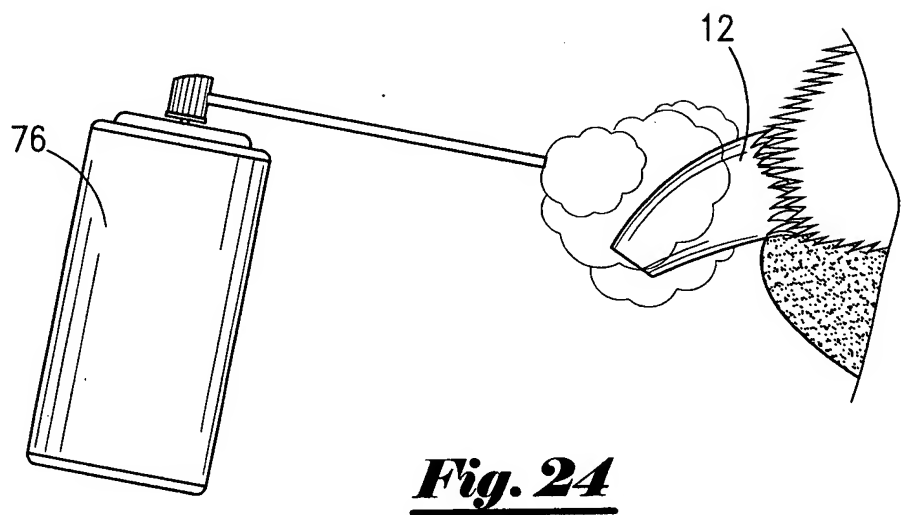
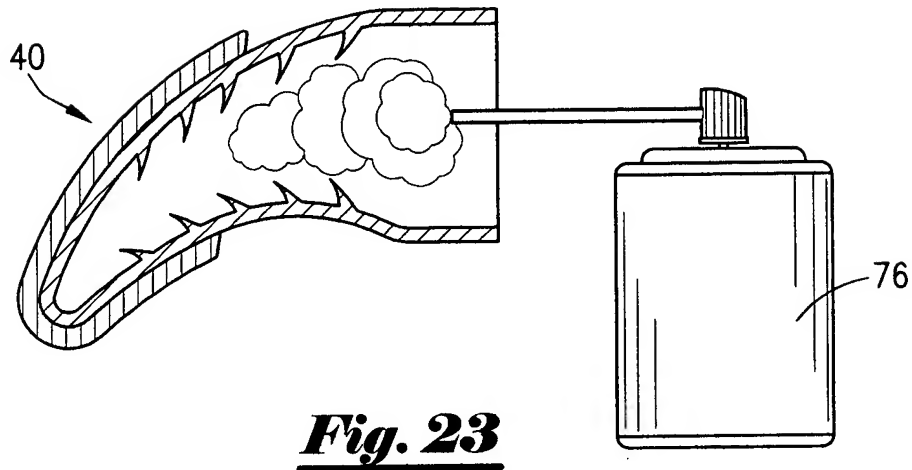


Fig. 6
PRIOR ART

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